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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599

12-19-03

Image

PATENT APPLICATION

ATTORNEY DOCKET NO. 10010381-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Invantor(s): Lefkowitz

Serial No.: 09/944,083

Examiner: My Chau T. Tran

Filing Date: 08-31-2001

Group Art Unit: 1639

Title: Methods for Generating Ligand Arrays Via Deposition of Ligands onto Olefin Displaying Substrates, and Arrays Produced Thereby



COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

(X) Response/Amendment () Petition to extend time to respond
(X) New fee as calculated below () Supplemental Declaration
() No additional fee (Address envelope to "Mail stop Non-Fee Amendments")
(X) Other: Petition Under 1.78(a)(3), Declaration, postcard (fee \$ 1,330.00)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$86	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$290	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$420.00	3RD MONTH \$950.00	4TH MONTH \$1480.00		\$ 0
OTHER FEES					\$ 1,330	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$ 1,330	

Charge \$ 1,330 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

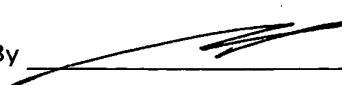
"Express Mail" label no. EV333998287US

Date of Deposit 12-17-2003

Respectfully submitted,

Lefkowitz

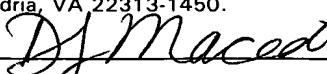
By


Bret Field for Gordon Stewart

Attorney/Agent for Applicant(s)
Reg. No. 37,620

Date: 12-17-2003

I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

By 
Donna Macedo

Typed Name: Donna Macedo



**Petition Under
37 C.F.R. § 1.78(a)(3)**

Application Number	09/944,083
Attorney Docket Number	10010381-1
Filing Date	August 31, 2001
First Named Inventor	Lefkowitz
Examiner	My Chau T Tran
Group Art	1639
Confirmation number	1180
Title	Methods for Generating Ligand Arrays Via Deposition of Ligands onto Olefin Displaying Substrates, and Arrays Produced Thereby

Sir:

Applicants hereby petition to amend the specification to make a claim to priority to the filing date of U.S. Patent Application serial no. 09/145,015, pursuant to 37 C.F.R. § 1.78(a)(3). The entire delay between the date that the claim was due under paragraph 37 C.F.R. § 1.78(a)(2)(ii) and the present request was unintentional. Enclosed with this response is the requisite: (1) processing fee pursuant to 37 C.F.R. § 1.17(t).

Respectfully submitted,

Date: December 17, 2003

By:


Bret Field
Registration No. 37,620

encls:

- Fee pursuant to 37 C.F.R. § 1.17(t)

12/24/2003 MGE BREM1 00000024 501078 09944083

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**RESPONSE TO ADVISORY
ACTION**

Application Number	09/944,083
Attorney Docket Number	10010381-1
Filing Date	August 31, 2001
First Named Inventor	Lefkowitz
Examiner	My Chau T Tran
Group Art	1639
Confirmation number	1180
Title ~	Methods for Generating Ligand Arrays Via Deposition of Ligands onto Olefin Displaying Substrates, and Arrays Produced Thereby

Sir:

In response to the Advisory Action dated November 21, 2003 and further to the response filed on October 31, 2003, the following additional comments and materials are provided:

REMARKS

Amendment to the Inventorship

In the Advisory Action, the Examiner states that the amendment to the inventorship was not entered because a new oath signed by all of the inventors was not included with the response. Enclosed with this response are declarations filed by all of the inventors. Accordingly, entry of the amendment to inventorship is respectfully requested as all of the necessary documents for such have been submitted to the Patent Office.

Amendment to the Specification

The Examiner did not amend the specification regarding the claim for priority for the asserted reason that a separate petition did not accompany the response. It is respectfully submitted that the previously filed request also served as the the Applicants' petition. Nonetheless, enclosed with this response is the requested separate petition. As a separate petition has now been filed along with the requisite fee, amendment to the specification as previously requested to claim to priority to the

filing date of U.S. Patent Application serial no. 09/145,015, pursuant to 37 C.F.R. § 1.78(a)(3) is now proper.

Amendment to the Claims

As previously explained, all of the claims have been amended to specify that the olefin displaying surface of the substrate is produced by contacting the surface with an olefin-silane derivatizing composition, support for this amendment being found in the specification in paragraphs 40 to 46, among other locations. New claims 50 and 51 find support in the specification specifically at page 19, paragraph 71. Accordingly, contrary to the assertion raised in the Advisory action, new claims 50 and 51 do not raise issues of new matter.

Rejection of Claims under 35 U.S.C. § 103

Claims 7-14, 16-23, 25-26 and 44-49 remain rejected under 35 U.S.C. § 103(a) as being obvious over Sundberg in view of Wang, for the asserted reason that the combined teachings of these references teach a method of producing a ligand array by attaching ligands to a functionalized surface, which combined teaching assertedly renders the claimed invention obvious.

However, a feature of the pending claims is that the substrate which is contacted with the ligands in the claimed methods is one that is provided by "**contacting said surface with a derivatizing composition comprising at least a first silane having an olefin functional group...**" As such, the claimed methods are limited in that the surface of the substrate employed in the claimed methods must be produced by contacting the substrate surface with a derivatizing composition that includes a silanating agent having an olefinic functional group, i.e., a functional groups that includes a carbon-carbon double bond.

Both Sundberg and Wang describe functionalized surfaces in general, but fail to teach or suggest such a surface-derivatizing step, as required in the claims.

As such, the combined teaching of Sundberg and Wang fails to teach or suggest the claimed methods. Accordingly, Claims 7-14, 16-23, 25-26 and 44-47 are not obvious under 35 U.S.C. § 103(a) over Sundberg in view of Wang and this rejection may be withdrawn.

Next, Claims 7, 15-16 and 24 are rejected under 35 U.S.C. § 103(a) as being obvious over Sundberg in view of Wang, and further in view of Gleason.

As explained above, a feature of the pending claims is that the substrate which is contacted with the ligands in the claimed methods is one that that is provided by "**contacting said surface with a derivatizing composition comprising at least a first silane having an olefin functional group...**" As such, the claimed methods are limited in that the surface of the substrate employed in the claimed methods must be produced by contacting the substrate surface with a derivatizing composition that includes a silanating agent having an olefinic functional group, i.e., a functional groups that includes a carbon-carbon double bond.

Both Sundberg and Wang describe functionalized surfaces in general, but fail to teach or suggest such a surface-derivatizing step, as required in the claims. Gleason also fails to teach or suggest such a surface derivatizing step, as required in the claims, as required in the claims.

As such, the combined teaching of Sundberg and Wang in view of Gleeson fails to teach or suggest the claimed methods. Accordingly, Claims 15-16 and 24 are not obvious under 35 U.S.C. § 103(a) over Sundberg in view of Wang and further in view of Gleeson and this rejection may be withdrawn.

CONCLUSION

The applicant respectfully submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Gordon Stewart at 650 485 2386. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date: December 17, 2003

By: 
Bret Field
Registration No. 37,620

encls:

- Petition under 37 C.F.R. § 1.78(a)(3) and fee pursuant to 37 C.F.R. § 1.17(t)
- Declaration by Inventors

DATE: December 17, 2003



EV333998287US

THE EXPRESS MAIL NUMBER OF THE DAY IS: EV333998287US

The person taking the Express Mail to the Post Office is: Alicia Silvestrini

EXPRESS MAIL CERTIFICATION

Date of Deposit: 12/17/2003 I hereby certify that the below-listed papers or fees were inserted into a package addressed to: Commissioner for Patents, PO BOX 1450, Alexandria, Virginia 22313-1450 and was deposited by me with the United States Postal Service "Express Mail Post Office Addressee" service under 37 C.F.R. § 1.10 on the date indicated above.

Signature

Date

12/17/03

Atty. Docket No.	Serial Number	Description	Atty.	Fee
RIGL-004CON2	09/916,940	Interview Summary	PJS	
STAN-258US1	10/367,405	Transmittal, IDS, SB08A, Copy of International Search Report dated 11/26/03, Copies of (2) Cited References	PJS	
AGIL-016	.09/944,083	Transmittal <i>in duplicate</i> , Response to Advisory Action, Petition under 1.78(a)(3), Executed Declaration <i>in counterparts</i>	BEF	\$1,330
AERX-076CIP	10/649,376	Transmittal, Fee Transmittal <i>in duplicate</i> , ADS, Copy of Notice to File Missing Parts, Executed Declaration	KYB	\$1,180
STAN-166	09/716,054	Notice of Appeal <i>in duplicate</i> (Petition for a 3 mos. ext. of Time)	BEF	\$1,170
UCAL-230CIP	10/265,071	IDS, SB08A, Copies of 2 Cited References	PAB	
STAN-258CIP	10/716,846	Transmittal, IDS, SB08A, Copy of International Search Report dated 11/26/2003	PJS	
UCAL-230	10/025,966	Transmittal, IDS, SB08A, Copies of (2) Cited References	PAB	
BERK-020	10/145,648	PTOL-85B <i>in duplicate</i>	PAB	\$965